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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,346	11/15/2000	Mario Pagliaro	PAGLIAR01	9119
1444	7590	01/15/2004	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C.			LEWIS, PATRICK T	
624 NINTH STREET, NW			ART UNIT	
SUITE 300			PAPER NUMBER	
WASHINGTON, DC 20001-5303			1623	

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/646,346

**Applicant(s)**

PAGLIARO ET AL.

**Examiner**

Patrick T. Lewis

**Art Unit**

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-7,9-11,14-17,19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 and 21 is/are allowed.
- 6) ☒ Claim(s) 3-7,10,11,19,22,24 and 25 is/are rejected.
- 7) ☒ Claim(s) 9,14 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 01122004.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Applicant's Response dated October 8, 2003***

1. In the Response filed October 8, 2003, claim 21 was amended; claims 1-2, 8, 12-13, 18, and 20 were canceled; and claim 25 was added. Applicant presented arguments directed to the rejection of claim 18 (rewritten as new claim 25) under 35 U.S.C. 102(b). Claims 3-7, 9-11, 14-17, 19, and 21-25 are pending. An action on the merits of claims 3-7, 9-11, 14-17, 19, and 21-25 is contained herein below.
2. The rejection of claim 18 under 35 U.S.C. 102(b) has been rendered moot in view of applicant's amendment dated October 8, 2003.

### ***Claim Objections***

3. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 14 and 23 are objected to because of the following informalities: In step b) of claim 23 the phrase "or a precursor thereof of formula," does not clearly convey what "formula" applicant is referencing. The examiner suggests identifying the formula by name, number, or location in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-7, 10-11, 19, 22, and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "precursor" as set forth in independent claims 22 and 25 render said claims and subsequent dependent claims indefinite. In the absence of distinct modifications to the chemical core claimed or distinct language to describe the structural modifications or the chemical names of precursors of this invention, the identity of said precursors would be difficult to describe and the metes and bounds of said precursors applicant regards as the invention cannot be sufficiently determined because they have not been particularly pointed out or distinctly articulated in the claims. The term "precursor" is indefinite in all occurrences wherein the identity of said "precursor" has not been distinctly set forth. The examiner suggests amending to claim to recite "a compound that forms TEMPO under the instant reaction conditions" or the like in place of the term "precursor".

7. Claim 3 recites the limitation "said non-hydrolyzable substituent is H, an alkyl, aryl or fluoroalkyl group or an aminoalkyl group" in lines 2-4. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 4 and 5 recite the limitation "said step c)" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 19 recites the limitation "wherein P is a non-hydrolyzable substituent" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

***Conclusion***

10. Claims 3-7, 9-11, 14-17, 19, and 21-25 are pending. Claims 3-7, 10-11, 19, 22, and 24-25 are rejected. Claims 9, 14, and 23 are objected to. Claims 15-17 and 21 are allowed.

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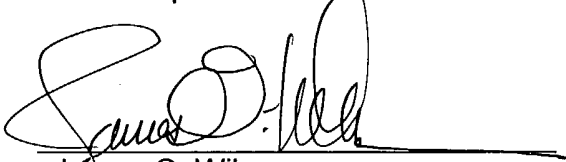
### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623



James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

ptl  
January 12, 2004